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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/677,619
Filing Date: October 02, 2003
Appellant(s): OGG, CRAIG

R. Ross Viguet
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/11/2009 appealing from the Office action mailed 12/11/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 9-12, 14-20 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 11

Appellant's claim 1 recites:

a postage computing device for separately calculating postage value due **for each individual mail piece**, said postage computing device operable to use said calculated postage value to generate an information based postage indicia for **an individual mail piece** in parallel **with the individual mail piece being physically created and processed** by at least one mail processing component of said two or more mail processing components.

As the claim is currently presented, there appears to be three separate types of individual mail pieces:

Mailpiece 1: The individual mail piece of the postage computing device.

Mailpiece 2: An individual mail piece that will contain generated information based indicia.

Mailpiece 3: The individual mail piece which is being physically created and processed by at least one mail processing component.

This is in glaring contrast to Appellant's remarks regarding the parallel process (see Appellant's remarks dated 02/13/2008; pg. 6 para. 2). It further makes the claim language unclear as to how many mail pieces are being discussed and the role of these

individual mail pieces at various points throughout the system and their relation to the claimed process. Furthermore, ***there is a lack of antecedent basis for the recitation, "the individual mail piece being physically created and processed..." (see line 7).***

Claim 11 recites similar claim limitations and also contains the same ***lack of antecedent basis error*** (see line 9).

For the reasons outlined above, the claim language is indefinite and unclear.

Accordingly for Examination purposes, the Examiner is interpreting Appellant's amendments with respect to claims 1 and 11 as not further limiting.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,742,878	Freeman et al.	5-1988
2001/0042052 A1	Leon	11-2001
5,612,888	Chang et al.	3-1997
6,041,569	Freeman et al.	3-2000
6,173,274	Ryan, Jr.	1-2001
416,736	Manduley et al.	1-1992
2004/0088267 A1	Rasmussen et al.	5-2004
201,764	Huggett et al.	5,468,945

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

New Grounds-Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 9-12, 14-20 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 11

Appellant's claim 1 recites:

a postage computing device for separately calculating postage value due ***for each individual mail piece***, said postage computing device operable to use said calculated postage value to generate an information based postage indicia for ***an individual mail piece*** in parallel ***with the individual mail piece being physically created and processed*** by at least one mail processing component of said two or more mail processing components.

As the claim is currently presented, there appears to be three separate types of individual mail pieces:

Mailpiece 1: The individual mail piece of the postage computing device.

Mailpiece 2: An individual mail piece that will contain generated information based indicia.

Mailpiece 3: The individual mail piece which is being physically created and processed by at least one mail processing component.

This is in glaring contrast to Appellant's remarks regarding the parallel process (see Appellant's remarks dated 02/13/2008; pg. 6 para. 2). It further makes the claim language unclear as to how many mail pieces are being discussed and the role of these individual mail pieces at various points throughout the system and their relation to the claimed process. Furthermore, ***there is a lack of antecedent basis for the recitation, "the individual mail piece being physically created and processed..." (see line 7).***

Claim 11 recites similar claim limitations and also contain the same ***lack of antecedent basis error*** (see line 9).

For the reasons outlined above, the claim language is indefinite and unclear.

Accordingly for the purposes of Examination, the Examiner is interpreting a system that is able to generate indicia while concurrently processing another mail piece, as meeting the limitations of the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. U.S. Patent No. 4,742,878 in view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1.

As per Claim 1, Freeman teaches, a postage computing device for separately calculating postage value due for each individual mail piece of said plurality of mail pieces (see Col. 2 lines 11-17), said postage computing device operable to use said calculated postage value to generate postage indicia for an a mail piece of said plurality of mail pieces in parallel with the mail piece of said plurality of mail pieces being physically created and processed by at least one mail processing component of said two or more mail processing components (see Col. 9 lines 33-40).

a postage application printer positioned to print said postage indicia on the mail piece of said plurality of mail pieces that is being moved by the conveyor system (see Col. 9 lines 47-48), wherein said postage indicia is available for printing by said postage application printer at the time the mail piece of said plurality of mail pieces arrives at said postage application printer (see Col. 9 lines 50-52); Freeman does not explicitly teach the system taught by Leon, a computer processing system for storing information related to the processing of each mail piece and for providing the controller with the processing information (see para. 96). Although Freeman does not teach information based indicia, Leon further teaches generate information based indicia and printing information based indicia (see para. 87; 45 and 46). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Freeman to include the teachings of Leon in order to make share information regarding items to be posted accessible and use technological advances in computers and their networks, as taught by Leon para. 96 and 73.

Claims 2 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. U.S. Patent No. 4,742,878 in view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1 in further view of Chang et al. U.S. Patent No. 5,612,888.

As per Claim 2, Freeman in view of Leon teaches the system of claim 1 as described above. Freeman does not explicitly teach a quality control unit adapted to monitor the postage value calculated by the postage computing device. Chang teaches a quality control unit for monitoring the postage value calculated by the postage computing device (see Col. 3 lines 10-14). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Freeman and Leon to include the teachings of Chang in order to maintain integrity in the event of a fault, as taught in Chang Col. 3 lines 10-14.

As per Claim 5, Freeman in view of Leon teaches the system of claim 1 as described above. Freeman does not explicitly teach wherein the controller and the computer processing system are the same device. Chang teaches the controller and the computer processing system are the same device (see Col. 2 lines 38-43 and Col. 3 lines 10-14). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Freeman and Leon to include the teachings of Chang in order to enable a flexible architecture, as taught in Chang Col. 3 lines 5-7.

As per Claim 6, Freeman in view of Leon teaches the system of claim 1 as described above. Freeman does not explicitly teach wherein the controller, the

computer processing system and the postage computing device are the same device. Chang teaches wherein the controller, the computer processing system and the postage computing device are the same device (see Col. 2 lines 38-43). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Freeman and Leon to include the teachings of Chang in order to enable a flexible architecture, as taught in Chang Col. 3 lines 5-7.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. U.S. Patent No. 4,742,878 in view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1 in further view of Freeman U.S. Patent No. 6,041,569 (Hereinafter, "Freeman 2").

As per Claim 7, Freeman in view of Chang teaches the system of claim 1 as described above. Freeman does not explicitly teach the system taught by Freeman 2, wherein the postage application printer is a high-speed ink jet printer (see Col. 7 lines 57-62). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Freeman and Leon to include the teachings of Freeman 2 in order to enable high speed indicia printing.

Claims 3-4 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. U.S. Patent No. 4,742,878 in view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1 in further view of Ryan, Jr. U.S. Patent No. 6,173,274 B1.

As per Claim 3, Freeman in view of Leon teaches the system of claim 1 as described above. Freeman does not explicitly teach a mail piece printer for printing

documents that will be combined into the mail pieces. Ryan teaches a mail piece printer for printing documents that will be combined into the mail pieces (see Col. 5 lines 23-30). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Freeman and Leon to include the teachings of Ryan to produce high volume mail-pieces, as taught in Ryan Col. 5 lines 31-35.

As per Claim 4, Freeman in view of Leon teaches the system of claim 1 as described above. Freeman does not explicitly teach wherein the mail processing components include at least one of a folder and an inserter. Ryan teaches the mail processing components include a folder and an inserter (see Col. 5 lines 20-21 and Col. 6 lines 45-52). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Freeman and Leon to include the teachings of Ryan to produce customized documents corresponding to an individual customer account.

As per Claim 9, Freeman in view of Leon teaches the system of claim 1 as described above. Freeman does not explicitly teach wherein the postage application prints other information on the mail piece of said plurality of mail pieces in addition to the postage information. Ryan teaches the postage application prints other information on one or more of the mail pieces in addition to the postage information (see Col. 7 lines 29-34). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Freeman and Leon to include the teachings of Ryan to allow address information to be included for mailpiece delivery.

As per Claim 10, Freeman in view of Ryan teaches the system of claim 9 as described above. Freeman does not explicitly teach wherein the additional information includes one or more items selected from the group consisting of: marketing information; address information; and an envelope border. Ryan teaches wherein the additional information includes one or more items selected from the group consisting of: marketing information; address information; and an envelope border (see Col. 7 lines 29-34). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Freeman and Leon to include the teachings of Ryan to allow address information to be included for mailpiece delivery.

Claims 11-12, 15-16 and 18 are rejected under 35 U.S.C. 103(a) as being anticipated by Ryan, Jr. U.S. Patent No. 6,173,274 B1 in view of Freeman U.S. Patent No. 4,742,878 in further view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1.

As per Claim 11, Ryan teaches receiving processing instructions that identify how each mail piece of said mail pieces should be processed (see Col. 4 lines 17-28); controlling the components of the high-speed processing system to comply with the processing instructions (Col. 4 lines 13-28); individually calculating a postage value for said each mail piece of said mail pieces (see Col. 7 lines 12-14); and printing the calculated postage value on each mail piece (see Col. 7 lines 1-4). Ryan does not explicitly teach the method taught by Freeman; generating postage indicia, using said calculated postage value, for an individual mail piece in parallel with the individual mail piece being physically processed for one or more of the components, including at least one of a folder and an inserter of said high-speed mail processing system (see Col. 9

lines 33-40).; and wherein said postage indicia is available for printing at the same time the corresponding one of the mail pieces arrives at a printer for said printing (see Col. 9 lines 50-52). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Ryan to include the teachings of Freeman to provide a mixed weight mailing system having improved singulating capability, as taught in Freeman Col. 2 lines 3-5. Although Freeman does not teach information based indicia, Leon further teaches generate information based indicia and printing information based indicia (see para. 87; 45 and 46). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Ryan and Freeman to include the teachings of Leon in order to use technological advances in computers and their networks, as taught by Leon para. 96 and 73.

As per Claim 12, Ryan in view of Freeman and Leon teaches the method of claim 11 as described above. Ryan further teaches folding the mail pieces (see Col. 6 lines 45-47); inserting the mail pieces into an envelope (see Col. 6 lines 52-54); and printing the calculated postage on each envelope (see Col. 7 lines 1-4).

As per Claim 15, Ryan in view of Freeman and Leon teaches the method of claim 11 as described above. Ryan further teaches printing other information on one or more of the mail pieces in addition to the postage value for that piece (see Col. 7 lines 29-34).

As per Claim 16, Ryan in view of Freeman and Leon teaches the method of claim 11 as described above. Ryan further teaches wherein the other information includes one or more items selected from the group consisting of: marketing information; address information; and an envelope border (see Col. 7 lines 29-34).

As per Claim 18, Ryan in view of Freeman and Leon teaches the method of claim 11 as described above. Ryan further teaches printing documents to be included in each mail piece prior to folding the mail piece (see Col. 5 lines 65-67).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan, Jr. U.S. Patent No. 6,173,274 B1 in view of Freeman U.S. Patent No. 4,742,878 in further view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1 and Manduley et al. U.S. Patent No. 5,079,714.

As per Claim 14, Ryan teaches the method of claim 11 as described above. Ryan does not explicitly teach wherein the postage value is calculated without weighing the mail pieces. Manduley teaches wherein the postage value is calculated without weighing the mail pieces (see Col. 8 lines 39-44). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the methods of Ryan, Freeman and Leon to include the teachings of Manduley in order to utilize a computer which maintains a database and inserts of their weights, as taught in Manduley Col. 8 lines 40-44.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan, Jr. U.S. Patent No. 6,173,274 B1 in view of Freeman U.S. Patent No. 4,742,878 in further view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1 and Chang et al. U.S. Patent No. 5,612,888.

As per Claim 17, Ryan in view of Freeman in further view of Leon teaches the method of Claim 11 as described above. Ryan does not explicitly teach, performing a quality control analysis on one or more of the calculated postage values. Chang teaches

performing a quality control analysis on one or more of the calculated postage values (see Col. 3 lines 10-14). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the methods of Ryan, Freeman and Leon to include the teachings of Chang in order to maintain integrity in the event of a fault, as taught in Chang Col. 3 lines 10-14.

Claim 19 is rejected under 35 U.S.C. 103(a) as being anticipated by Ryan, Jr. U.S. Patent No. 6,173,274 B1 in view of Freeman U.S. Patent No. 4,742,878 in further view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1 and Rasmussen et al. 20040088267 A1.

As per Claim 19, Ryan teaches means for receiving processing instructions that identify how each mail piece should be processed (see Col. 4 lines 17-28); means for controlling the components of a high-speed processing system in accordance with the processing instructions (see Col. 4 lines 13-28); and a printer for printing the calculated postage value on each mail piece (see Col. 7 lines 1-4). Ryan does not explicitly teach the system taught by Rasmussen means for calculating a postage value for each individual mail piece based upon a count of the number of documents included in each said individual mail piece and weights of the documents; said weights determined, and postage value calculated, without weighing the individual mailpiece using information from said processing instructions, and in parallel with the high-speed processing of said mail piece (see para. 12 and para. 13). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Ryan to include

the teachings of Rasmussen to determine weight based deliver fee, as taught by Rasmussen para. 3.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan, Jr. U.S. Patent No. 6,173,274 B1 in view of Freeman U.S. Patent No. 4,742,878 in further view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1 and Rasmussen et al. 20040088267 A1 and Official Notice (as supported by Huggett).

As per Claim 20, Ryan teaches the method of claim 19 as described above. Ryan further does not explicitly teach wherein the printer is a high-speed printer that is capable of printing the postage value at any position or orientation on the mail pieces. Official Notice is taken that a high-speed printer that is capable of printing at any position or orientation is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Ryan to include the teachings of Official Notice in order to speed up processing times.

Claim 22 is rejected under 35 U.S.C. 103(a) as being anticipated by Ryan, Jr. U.S. Patent No. 6,173,274 B1 in view of Freeman U.S. Patent No. 4,742,878 in further view of Leon U.S. Pre-Grant Publication No. 2001/0042052 A1 and Rasmussen et al. 20040088267 A1.

As per Claim 22, Ryan in view of Freeman and Leon teaches the method of claim 11 as described above. Ryan does not explicitly teach the method taught by Rasmussen, wherein a weight of each mail piece varies depending upon the number of pages included in each mail piece (see para. 13 and 18), and wherein the postage value for each mail piece is calculated based upon a count of the number of pages

included for that mail piece and weights of the pages (see para. 13). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Ryan to include the teachings of Rasmussen to determine weight based deliver fee, as taught by Rasmussen para. 3.

(10) Response to Argument

A. Appellant fails to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

Appellant argues with respect to claim 1 that the language, *"a postage computing device for separately calculating postage due for each individual mailpiece of said plurality of mail pieces, said postage computing device operable to use said calculated postage value to generate an information based postage indicia for a mail piece of said plurality of mail pieces in parallel with the mail piece of said plurality of mail pieces being physically created and processed by at least one mail processing component of said two or more mail processing components"* plainly describes that "the parallel process is found in that the system is able to generate indicia for an individual mail piece while simultaneously processing that same individual mail piece" (see Appellant's remarks dated 02/13/2008; pg. 6 para. 2). The Examiner disagrees.

As the claim is currently presented, there appears to be three separate types of individual mail pieces:

Mailpiece 1: The individual mail piece of the postage computing device.

Mailpiece 2: An individual mail piece that will contain generated information based indicia.

Mailpiece 3: The individual mail piece which is being physically created and processed by at least one mail processing component.

This is in glaring contrast to Appellant's remarks regarding the parallel process. It further makes the claim language unclear as to how many mail pieces are being discussed and the role of these individual mail pieces at various points throughout the system and their relation to the claimed process. There is also a lack of antecedent basis for the term, "the individual mail piece being physically created and processed..."

The lack of clarity in Appellant's claim language hinders the interpretation of the claim language being argued by Appellant.

For the purposes of Examination, the Examiner interpreted a system that is able to generate indicia while concurrently processing another mail piece, as meeting the limitations of the claim.

B. The cited references teach the interpreted claim language

Freeman is directed to a postage computing device that separately calculates the postage value due for each individual mail piece of a plurality of mail pieces, the postage computing device of Freeman uses the calculated postage value to generate postage indicia for a mail piece of the plurality of mail pieces while concurrently processing another mail piece. Specifically Freeman teaches,

The above objects are achieved and the disadvantages of the prior art are overcome in accordance with the subject invention by means of a mailing system which includes a feeder system for sequentially singulating mailpieces from a batch of mailpieces; a weighing system for weighing the singulated mailpieces, computing the necessary postage amounts for each of the singulated

mailpieces as a function of their weight, and transmitting the necessary postage amounts; (see Col. 2 lines 11-17)

Feeder 50 continues to operate until time T3 to singulate the next mailpiece mp2 at time T3 and then stops. By time T4 scale module 20 will determine the weight of mailpiece mp1 and compute the corresponding postage amount. Scale module 20 then transmits this postage amount to postage meter 15 over link 15A and postage meter 15 then sets its indicia correspondingly. When the indicia are properly set postage meter 15 signals transport control 38 at time T5 through link 15A and scale electronics 36. At time T5 transport control 38 again turns on motors M1 and M2 and singulator 52 to begin transport of mailpiece mp1 from scale module 20 to mailing machine 12 and mailpiece mp2 from feeder 50 to scale module 20. At time T6 mailpiece mp1 is taken by sealer rollers 16 and a print cycle begins. At time T7 mailpiece mp2 is transported onto scale module 20 and the next weigh cycle begins. At time T6 mailpiece mp1 is advanced by sealer rollers 16 until it reaches trip switch 18 which initiates printing by drum 19. At time T8 mailpiece mp1 is printed with indicia corresponding to the appropriate postage and ejected to stacker 200. Mailing machine 12 is an asynchronous machine which operates continuously, and once a mailpiece is taken by sealer rollers 16 a print cycle will automatically continue until completion. At time T9 the weigh time for mailpiece mp2 is completed and at time T10 meter 15 is again appropriately set and the mailpiece for the next cycle (not shown) is advanced onto scale module 20 (see Col. 9 lines 33-40).

As demonstrated above, Freeman in view of Leon does in fact teach the claim language properly construed in accordance with the Examiner's interpretation

and the recited claim language. Furthermore, all the elements and their functions remain the same and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Appellant further argues with respect to claim 11 that Freeman does not teach the components including at least one of a folder and inserter, as asserted by the Examiner is the Final Office Action. The Examiner notes that the reliance on Freeman, as opposed to Ryan, teaching this feature was a typographical error. The Examiner noted in claim 4 that Freeman did not teach mail components including at least one of a folder and inserter and Ryan was introduced to remedy the deficiency. Ryan teaches the mail processing components including a folder and an inserter (see Col. 5 lines 20-21 and Col. 6 lines 45-52). Further, the combination of Ryan and Freeman would be obvious to one of ordinary skill in the art and would yield predictable results.

Appellant further asserts that Rasmussen does not teach determining the postage value of a mailpiece without weighing. The Examiner disagrees. Specifically, Rasmussen plainly teaches

The present invention streamlines this process by determining the weight of the package prior to its creation, creating the contents of the package, packaging the material and informing the metering device of the total calculated weight for the package so that the appropriate postage may be affixed to the package (see para. 10).

As demonstrated above, Rasmussen teaches the limitation as recited.

Appellant further asserts that the Examiner's taking of Official Notice as supported by Huggett is improper. The Examiner disagrees. Huggett was introduced in the Final Office Action to support the Examiner's assertion that a high-speed printer that is capable of printing at any position or orientation was old and well known in the art at the time of invention. Huggett describes a printer system that prints postage labels at random positions and orientations (see Col. 3 lines 1-20).

The Examiner notes: Appellant asserts with respect to all of the dependent claims that the combined references do not teach operating a system in parallel. As described above, with respect to claim 1, the prior art of record properly construed in accordance with the Examiner's interpretation and the recited claim language teaches the Appellant's invention.

C. Appellant argues the claim more narrowly than recited

Appellant further asserts, with respect to claim 2, that Chang does not teach a quality control unit adapted to monitor a postage value calculated by a postage computing device. The Examiner disagrees. Specifically, Chang teaches,

Central control process 2 includes the mailpiece coordinator task 20 which tracks the processing order of a mailpiece in the mailing system and error handling task 40 which maintains mailpiece integrity in the event the mailing system experiences a fault. The mailpiece coordinator task 20 generates a table 24 for each mailpiece in the mailing system. The table 24 includes the mailpiece attributes which are required for the mailpiece. Mailpiece attributes used in a

preferred embodiment of the subject invention are set forth in Table 1 (see Col. 3 lines 10-45).

Print Postage- Indicates whether an indicia is

needed for the mailpiece. If so, the postage value is indicated. (see Table 1).

As demonstrated above, the mail piece coordinator task monitors the mailpiece throughout the system including the indicia need for a mailpiece.

D. The claimed invention is expressly suggested in the references.

Appellant asserts with respect to claim 4 and 12 that the combination of Freeman, Leon and Ryan does not create the claimed invention. The Examiner disagrees. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Accordingly, the Examiner respectfully maintains that the rejections are proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Tonya Joseph

/Tonya Joseph/

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

Vincent Millin,/vm/

Appeals Practice Specialist
